

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

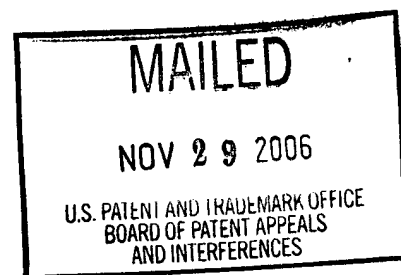
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Uwe Hansmann, Lothar Merk, and
Thomas Stober

Appeal No. 2006-3137
Application No. 10/037,700
Technology Center 2100

ORDER



Before THOMAS, DIXON, and SAADAT, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This is an Order remanding this application to the Examiner. From our initial review of the application and prosecution history, we note a number of items and issues that need to be addressed and clarified by the Examiner prior to our decision on the merits.

First, we note that the After-Final amendment filed with the original Brief, on Aug. 2, 2005, has not been addressed and entered by the Examiner. Additionally, we note the Appellants' corrected Brief indicates an amendment is filed therewith, but we find no such amendment. We assume that this was the amendment filed with the original Brief. The Examiner should address the amendment and mail an Advisory Action. If the amendment is not entered, then a corrected claims appendix is needed for Appellants' Brief.

Second, we note that the Examiner has not restated the rejection under 35 U.S.C. § 112, second paragraph, in the Answer, but has agreed with Appellants' statement of the grounds of rejection to be reviewed (Brief, page 6 and Answer, page 2). Clarification is required as to whether this rejection is maintained or withdrawn.

Third, the Examiner listed the Bauer reference in the first Office action and in the Final with a different patent number in the rejection under 35 U.S.C. § 102 than the Bauer reference used in the 35 U.S.C. § 103 rejection. That reference is not named Bauer. Appellants did not mention this discrepancy, nor did the Examiner mention it. In the Examiner's Answer, the Examiner used the same Bauer reference 5,870,759. Clarification is needed whether this is the correct reference and a typographical error has been present throughout the prosecution or if this is a new ground of rejection.

Fourth, we note that the Appellants' claims on appeal include means plus function limitations, but we do not find that the Summary of Claimed Subject Matter in the Brief, dated Oct. 18, 2005, specifically identifies any corresponding structure, acts, or materials in the specification to carry out the recited functions. Nor has the Examiner addressed these limitations or identified whether it would have been obvious to one skilled in the art, at the time of the invention, that the structure would have been known. This is a claim interpretation issue that the Appellants and the Examiner need to address before we can address the merits of the rejection under 35 U.S.C. §§ 102 and 103. We direct the Examiner's attention to MPEP § 2181 as it relates to 35 U.S.C. § 112, Paragraph six, as it

interacts with 35 U.S.C. § 112, Paragraphs One and Two. See MPEP § 2185 and the discussion of related issues.

Fifth, the Examiner is required to set forth claim interpretation as to how the “set up information” limits the client system in independent claim 21:

21. A client computer system for synchronizing data records stored on the client computer system with data records stored on a server system, the client computer system comprising:
a database for storing the data records; and
a processor coupled to the database for creating setup information to the server system,

wherein the setup information enables the server system to identify the client, to identify where to find information the server system needs for synchronization and to provide appropriate commands for the client.

Does the Examiner find that the set up information changes the recited structure of the client or the recited operation of the client in independent claim 21? Similarly, does the Examiner find that the set up information changes the recited structure of the server or the recited operation of the server in independent claim 26?


Accordingly, it is

ORDERED that the application is returned to the examiner to:


(1) address the merits of the after final amendment dated Aug. 2, 2005 and mail a communication to Appellants. The Examiner should require Appellants to correct the claims appendix to the Appeal brief, if the amendment is not entered;

(2) address the five items above; and require a new Appeal Brief and vacate the Examiner's Answer , if needed, to clarify the record for review; and

(3) for such further action as may be appropriate.



JAMES D. THOMAS
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

MAHSHID D. SAADAT
MAHSHID D. SAADAT
Administrative Patent Judge

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